REMARKS

Claims 33-38, 40-49 and 53 are pending. Claims 33, 36 and 37 have been amended. The amendments do not raise an issue of new matter and entry there-of is respectfully requested.

Rejections Under 35 U.S.C. § 112

Claims 33-38, 40-49 and 53 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly lacking written description for the term "histone analog". The Office alleges that the description of the genus histones fails to adequately describe histone analogues allegedly because the known histone proteins are not representative of a histone analog.

Applicant maintains that the description in the specification adequately conveys to those skilled in the art possession of the claimed invention. For example, Applicant's previous Response submitted extrinsic evidence showing that amino acid and polypeptide analogs were well known in the art at the time the invention was made. Nevertheless, to further prosecution of the subject application, Applicant has amended the claims to recite that the cell of the claimed method expresses expresses a labeled histone that associates with double minute chromosomes or extrachromosomal DNA to form a labeled complex. In light of this amendment, this ground of rejection is moot and withdrawal is respectfully requested.

Rejections Under 35 U.S.C. § 103

Claims 33-38, 40-49 and 53 stand newly rejected under 35 U.S.C. § 103(a) as allegedly obvious over Robinett et al. in view Abken et al. allegedly because the term "analog thereof" encompasses almost any protein that associates with double minute chromosomes or extrachromosomal DNA. In this regard, the Office asserts that Robinett et al. describe a method for visualizing chromosomes by expressing a lac repressor-nuclear localization signal fusion protein and that Abken et al. describe extrachromosomal DNA and double minute DNA as being chromosomal in origin. The Office maintains that the motivation to combine is provided by

Abken's alleged suggestion that agents that reduce double minute chromosomes result in tumor cell differentiation and may be a basis for therapeutic strategies.

Applicant maintains that the combination of Robinett et al. in view of Abken et al. fail to teach or suggest the invention as claimed. For example, the claimed histone analogs encompasses only those polypeptides that are structurally and functionally related to the claimed histone polypeptides, which are not taught or suggested by the cited art. Nevertheless, to further prosecution of the subject application, Applicant has amended the claims to recite that the cell of the claimed method expresses expresses a labeled histone that associates with double minute chromosomes or extrachromosomal DNA to form a labeled complex. In light of this amendment, this ground of rejection is moot and withdrawal is respectfully requested.

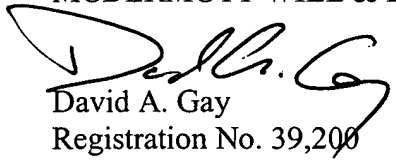
CONCLUSION

In light of the Amendments and Remarks herein, Applicant submits that the claims are in condition for allowance and respectfully requests a notice to this effect. Should the Examiner have any questions, she is invited to call the undersigned attorney.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP



David A. Gay
Registration No. 39,200

4370 La Jolla Village Drive, Suite 700
San Diego, CA 92122
858.535.9001 DAG:cec
Facsimile: 858.597.1585
Date: November 12, 2004